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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
10/018,576	02/20/2002	Ryo Sakai	0277-0002	5907

7590

06/04/2004

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EXAMINER

LE, HOA VAN

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10018,578

Applicant(s)

SAKAI ET AL.

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133)
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2004.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) (9, 11-13 and 30), (16-19) and (20, 22-29) is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) See Continuation Sheet are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-945)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims pending in the application are (1-6, 14, 31 and 33), (7-8, 15, 32 and 34), (9, 11 13 and 30), (16-19) and (20, 22-29).

Continuation of Disposition of Claims: Claims subject to restriction and/or election requirement are (1-6, 14, 31 and 33) and (7-8, 15, 32 and 34)).

This is in response to Papers filed 14 May 2004.

A. The record shows that the claims inventions are from the multiple Japanese priority applications.

B. Claims 30-34 are added. Claims 10, 21 and 28 are canceled.

C. The record shows that the fee of 29 claims have been paid only. A proper fee for the additional claims should have been timely made on 29 March 2004. A proper payment is requested and required in order for any further request to be considered.

D. A telephone call is made to Mr. Mark R. Shanks on 14 May 2004 to request an oral restriction. However, Mr. Shanks is not at his desk.

The record also shows that Mr. Shank requests a written Office action because his clients are overseas. The fact is that his clients are overseas. Accordingly, this Office action I made.

E. Applicants elect the material claims (1-6), (7-8), (14), (15) and (31-34) without traverse being acknowledged. Up on further reviewing, it is found that there are two patentably different and distinct types of metal oxide powders in the instant application. They should and must properly require two distinctively separate searches under 35 U.S.C. 121.

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F. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. The groups of claims (1-6), (14, 31 and 33) with independent 1 being broadest, drawn to a novel metal oxide powder of a conventional or known secondary battery, classified in class 429, subclass 209.
- II. The group of claims (7-8), (15, 32 and 34) with independent claim 7 being broadest, drawn to another patentably different and distinct metal oxide powder from that of the invention in Group I above, classified in class 429, subclass 218.1

Inventions of Group I and Group II are all related to the materials but are patentably different and distinct each from the other because they have acquired the separate status and searches in the art and can be supported the separate patents as divided by applicants and there is no evidence on the record that they are not required the separate consideration and search since they are the obvious variants because the prior art being applied to one invention would be sufficient against all of the above inventions. Therefore, separate consideration of search is required. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

Because these inventions are distinct for the reasons given above and have acquired the separate status and searches in the art and can be supported the separate patents as divided by applicants and have no evidence of the record that are not required the separate consideration and search since they are the obvious variants because the prior art being applied to one of them would be sufficient

against all inventions, restriction for examination purposes as indicated is proper. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

G. However any process claim is permitted to be rejoined with a material claim provided (a) that the material claim is allowable and (b) the process claim must be contained all of the limitations of the allowable material claim in accordance with the authority stated in *In re Ochiai*, 37 USPQ2d 1127 or *In re Brouwer*, 37 USPQ2d 1663 and MPEP 821.04.

If applicants would like a process claim to be rejoined with an elected material of either Group I or Group II above, applicants requested and required to clearly identify the process claim for the record.

H. Other issues have not been considered until a proper election is made and resolved.

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:00 PM on Monday though Thursday

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and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark F. Huff can be reached on 571-272-1385

Applicants may file a paper by fax with a central facsimile receiving number 703-872-9306,

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
01 June 2004

HOA VAN LE
PRIMARY EXAMINER
Hoa Van Le